

No. 231.

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UNITED STATES CIRCUIT COURT OF APPEALS  
NINTH CIRCUIT.

(October Term, 1894.)

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JOHN HAMMOND,

*Plaintiff in Error,*

*VS.*

STOCKTON COMBINED HARVESTER  
AND AGRICULTURAL WORKS,

*Defendant in Error.*

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Petition for Rehearing  
on Behalf of Plaintiff in Error.

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JOHN H. MILLER,

*Counsel for Petitioner.*

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PETITION FOR REHEARING.

To the Honorables W. B. GILBERT, Circuit Judge, E. M. Ross, Circuit Judge, and THOMAS P. HAWLEY, District Judge, sitting as and constituting the United States Circuit Court of Appeals for the Ninth Circuit, at the June session of the October term of 1894.

John Hammond, the plaintiff in error in this case, feeling himself agrieved by the judgment and decision of this court heretofore rendered in this case, comes now and petitions this court for a rehearing, upon the following grounds, namely:

*1st. In the opinion delivered in this case the court has failed to pass upon the precise point raised by the plaintiff in error, and upon which he relied for a reversal of the judgment.*

*2d. The court erred in holding that the letters patent sued on were void for want of invention.*

These propositions we shall briefly present, trusting that your Honors will give them a careful and critical

examination, inasmuch as this case is one of great importance to our clients, and we believe that the Court unconsciously fell into an error in deciding it.

## I.

WE SUBMIT AS OUR FIRST PROPOSITION FOR A REHEARING, THAT THIS COURT FAILED TO PASS UPON THE PRECISE POINT RAISED BY US ON THE HEARING AND UPON WHICH WE RELIED FOR A REVERSAL OF THE JUDGMENT.

The patent in suit is not for a *mechanical device*, but for a *new form and shape of a car-body*, issued under the provisions of section 4929 of the revised statutes providing for *design patents*.

This is the first case involving a design patent which has ever been brought to this court, and this fact may possibly tend to explain our contention that the court has fallen into an error. By this we mean to say, that heretofore all the cases relating to patents considered by this court have been cases involving patents for *mechanical inventions*, and in considering them this court has applied the rules applicable to those patents. Our contention is that a different rule must be applied to design patents, and that this distinction was not noticed by the court. Certainly it is not averted to in the opinion delivered.

The sole point involved in this case, both in the lower court and in this, was: Whether the patented design displayed an exercise of the inventive faculty. Every other issue in the case was found in favor of the plaintiff in error.

In determining whether the said design displayed any exercise of the inventive faculty, we are met at the very threshold of the controversy with the question: *Whether*

*or not in the case of design patents the same rigid rules as to invention apply as in the case of patents for mechanical inventions? Or to put the proposition in another form—is the same amount of inventive faculty required in producing a design as in producing a mechanical invention?*

Our precise contention on the hearing of this case was, that the same amount of invention *was not* required in producing a design, and consequently, that the question of invention as applied to design patents could not, and under the law was not, to be determined by the well known rigid rules applicable to mechanical inventions, but by modified and more liberal rules. And we further contended that when the design in question was tested by the latter rules, it would be found to display invention.

The opinion as rendered in this case is silent as to the above mooted point. The court does not appear to have considered the same. Certainly the opinion does not mention it, but disposes of the case *by applying the rigid rules applicable to mechanical inventions.*

We respectfully submit that we are entitled to a ruling on this special point which was raised by us and has not been decided. It is of vital importance, not only to us in this case but to all other litigants who base their claims for relief on design patents, a class of patents which of late years has been largely augmented. Consequently we ask for a rehearing in order that this point may be considered by the court and passed on for the future guidance of litigants in this line.

As stated above, this patent is not for *a mechanism*; it is for the *form, shape and configuration* of an article of

manufacture whereby a *pleasing appearance is presented to the eye*, and the article thereby made more desirable and hence valuable to the maker. Its object is to secure increased *beauty and pleasing effect*. Manifestly, therefore, such a product is radically different from one whose sole aim is functional utility.

In the case of a patent for a machine, say for instance a potato-digger, beauty is of no moment. Nor is shape, form or configuration. The object there sought is to provide a device which will successfully perform the useful operation of digging potatoes whatever may be its form, shape, configuration or appearance. Hence, the law has wisely established certain rigid rules by which to determine the presence of invention in such a case.

In contradistinction to this, consider the case of a design for the handle of a silver spoon, whose sole object is to secure a new form, shape, configuration or ornamentation which will add to the beauty of the spoon or pleasing effect on the eye, whereby it is rendered more acceptable to persons of æsthetic taste and consequently valuable to the maker. It is no more useful in the abstract sense, that is to say, as involving functional utility, than the old spoon. It is more beautiful and hence more desirable to purchasers. This makes it more salable, and consequently more remunerative to the designer. Hence, the law has also provided for this case, and allows a patent for the *æsthetic appearance caused by the new form, shape or configuration*. But a far different set of faculties is brought into play in producing such an article from those displayed in the other case stated. The two cases cannot be measured by the same rules of law.

This distinction is clearly made by the authorities, for Judge Coxe said, in rendering the decision in the case of *Untermeyer vs. Freund* (37 Fed. Rep., 344), (speaking of a design): “*It must be beautiful. It must appeal to the eye.*”

And so likewise, Mr. Justice Strong, in *Gorham vs. White* (14 Wall., 511), said that the Acts of Congress allowing patents for designs “were plainly intended to give encouragement to the decorative arts. They contemplate not so much utility as appearance; and that not an abstract impression or picture, but an aspect given to those objects mentioned in the acts. \* \* \* And the thing invented or produced, for which a patent is given, is that which gives A PECULIAR OR DISTINCTIVE APPEARANCE to the \* \* \* article.”

And so, too, Mr. Robinson in his work on patents (Vol. 1, p. 293), says: “The essence of a design resides in the idea of that *configuration* or *ornamentation* which constitutes the NEW APPEARANCE given.”

Judge Coxe went so far as to say in the opinion heretofore quoted (37 Fed. Rep., 344): “The policy which protects a design is akin to that which protects the works of an artist or a photographer by copyright.”

We endeavored to impress upon the court in our opening brief the distinction which is plainly made by the cases cited, but the opinion delivered seemed to pay no attention to the question. No mention is made of it; but, on the contrary, the patented design appears to be placed on the same plane with mechanical inventions and its sufficiency tested by the rigid rules applicable to mechanical inventions. We submit that this was error.



We were entitled to a more liberal rule of construction—the one applicable to designs. On that theory we staked our case. For the purpose of the argument we were willing to admit that an application of the rigid rules of invention applicable to mechanical devices might be fatal to our patent, but we insisted that such was not the proper test, and that, when the proper test was applied, namely, the rules applicable *solely to design patents*, then there would be found a sufficient modicum of invention present to warrant the court in sustaining the patent.

We think the difficulty arose from the fact that the courts on the Pacific Coast have for years been inquiring how much invention was necessary to sustain patents for *mechanical devices*, and thereby they have become thoroughly imbued with those rigid rules on the subject so often and emphatically announced by the Supreme Court for *testing mechanical inventions*. They have never before this case, so far as we are aware, been called on to construe a *design patent*. Under such circumstances we believe that the lower court unconsciously fell into the error of applying in this case those rules referred to, and that this court on appeal has followed in the steps of the lower court without adverting to the distinction we sought to make between mechanical and design patents. If this court had in the opinion rendered noticed the distinction we sought to make, a distinction clearly made by all the books and authorities, and had then decided that, notwithstanding such distinction, the patent in suit was void for want of *that small and insignificant amount of invention required in the case of design patents*, we would not now be afflicting the court with the petition for a re-



hearing. But in the decision rendered this court did not notice the distinction we make between mechanical and design patents, and applied to our design the rigid rules applicable only to mechanical patents, instead of the liberal rules applicable to design patents alone. We submit that we were entitled to a ruling on this issue and hence we request a rehearing for such purpose.

We believe that the foregoing considerations ought to influence the court to grant a rehearing without inquiring further into the merits of the controversy; but, for fear that the court might dispose of the matter by saying that, even if the liberal rules of invention applicable to design patents had been considered and applied, still the patent would have been held void for want of invention, we deem it prudent to go a step further and show that, when tested by those liberal rules referred to, the patent cannot be held void. Hence we make the second proposition on this petition for a rehearing as follows:

## II.

ON THE MERITS WE INSIST THAT THE PATENTED DESIGN DOES DISPLAY AN EXERCISE OF THE INVENTIVE FACULTY SUFFICIENT TO SUSTAIN THE PATENT. THE OPINION IN THIS CASE, AFTER STATING THE FACTS, SAYS:

“To entitle a party to a patent for a design under this Act there must be originality and exercise of the inventive faculty.”

This we are willing to admit, but the inquiry then remains: How much of the inventive faculty is required, and by what rules is its sufficiency tested? We insisted and do now insist that only a minimum of invention is required, and that its sufficiency must be tested not by

the rules applicable to mechanical patents, but by those applicable to design patents and to design patents alone. When so tested, we insist that the patent in suit is valid.

The opinion of this court then proceeds to quote a passage from the case of *Smith vs. Whitman Saddle Co.* (148 U. S., 674), as determinative of the case at bar, which is as follows:

“The exercise of the inventive or originative faculty is required, and a person cannot be permitted to select an existing form and simply put it to a new use any more than he can be permitted to take a patent for the mere double use of a machine. If, however, the selection and adaptation of an existing form is more than the exercise of the imitative faculty, and the result is in effect a new creation, the design may be patentable.”

We submit that there is nothing in this passage to militate against our views. It is true that an exercise of the inventive or originative faculty is required in producing a design. It is also true that a person cannot “select an existing form and simply put it to a new use and obtain a valid patent therefore.” That would be an existence of the well-known doctrine, double use. Illustrations of that are given in the opinion of the Supreme Court, quoted from (148 U. S., 674) as follows:

“The adaptation of old devices or forms to new purposes, however convenient, useful or beautiful they may be in their new roll, is not invention. Many illustrations are referred to, as for instance, the use of a model of the Centennial Building for paper weights and inkstands; the thrusting of a gas-pipe through the leg and arm of the statue of a shepherd boy for the purpose of a drop-

light; the painting upon a familiar vase of a copy of Stuart's portrait of Washington—none of which were patentable, because the elements of the combination were old.”

There was no such question involved in the case at bar. It cannot be contended that Hammond took an existing form and applied it to a new use. What he did do was to duplicate an old form to produce *a new article of manufacture*, to wit: *a double-ender cable car which has a new appearance and is capable of new functions*. We submit, therefore, that the quotation taken from the Supreme Court decision *supra*, is not authority for the decision rendered in this case. The opinion of this court concludes as follows:

“In the case at bar what the plaintiff did and all that he did was to substitute for the platform, which had previously been used on the rear end of the Market street car, an open compartment precisely similar to the open compartment which was in use at the front end of those cars. This was nothing more than the exercise of the imitative faculty and did not rise to the dignity of invention.”

It is quite true that in producing or manufacturing the second dummy Hammond merely copied (imitated) the old dummy, and, so far as the *mechanical operation* performed is concerned, that was an exercise of the imitative faculty; but the invention lay in *the original thought, idea, conception, that by such duplication a form would be produced presenting a new and pleasing appearance to the eye and capable of new and useful functions never performed before*.

There was no imitative faculty exercised in thinking out and conceiving that such results would be produced by duplication of the old 'dummy. The old dummy had never been duplicated before. Such duplication was a thing entirely unheard of and Hammond was the first to conceive of it. That was a purely originaive, mental act. After this original conception was once worked out, or had flashed across his mental vision, then it was merely an imitative act to produce the second dummy, and the only imitative act in the entire transaction was the *actual manual building of the second dummy*. That *manual* act was no part of the invention. It may not even have been performed by Hammond, because it is not to be presumed that he actually with his own hands built the second dummy. He ordered his workmen to do it. After having originated the idea or conception that by duplicating the dummy he could produce a new article having a new form and appearance, and before such actual manual duplication had been made, he ordered his workmen to remove the platform, which had previously been used on the rear end of the Market street car, and to substitute therefore a second dummy similar to the one already in use at the other end of that car. The workmen did so, and in so doing his act was "nothing more than the exercise of the imitative faculty," but the original mental conception of Hammond was on a far different footing. He exercised no imitative faculty, but one which we submit was purely originaive. It was the "selection and adaptation of an existing form which was more than the exercise of the imitative faculty." It was an original thought.

The question then is: *Did it require an exercise of the inventive faculty to conceive, originate and work out that mental idea and embody it in practical form?* To determine this point we have but to apply the test laid down by the Supreme Court in the celebrated case of *Gorham vs. White* (14 Wall., 511). That case involved a patent for a design used on spoons and forks, and the court said:

“The acts of congress which authorize the grant of patents for designs, were plainly intended to give encouragement to the *decorative arts*. They contemplate not so much utility as appearance, and that not an abstract impression or picture, but as an aspect given to those objects mentioned in the acts \* \* \* and the thing invented or produced for which a patent is given is that which gives a *peculiar or distinctive appearance* to the manufacture or article to which it may be applied or to which it gives form. The law manifestly contemplates that giving certain new and original appearances to a manufactured article may enhance its salable value, may enlarge the demand for it, and may be of meritorious service to the public. It therefore proposes to secure, for a limited time, to the producer of those appearances the advantages flowing from them. Manifestly, the mode in which those appearances are produced has very little, if anything, to do with giving increased salableness to the article. It is the appearance itself which attracts attention and calls out favor or dislike. *It is the appearance itself, therefore, no matter by what agency caused, that constitutes mainly, if not entirely, the contribution to the public which the law deems worthy of recompense.* The appearance may be the result of peculiarity of configuration, or of ornament



alone, or of both conjointly, but in whatever way produced, it is the new thing or product which the patent law regards. To speak of the invention as a combination or process, or to treat it as such, is to overlook its peculiarities."

The design which was covered by the patent in that case was a very simple scroll work used on the handles of silver forks and spoons. A representation of it is found at page 521 of the decision (14 Wall). If there were any invention involved in producing that design, we affirm with the utmost confidence in our position that the inventive faculty was likewise displayed in producing the Hammond double-ended car, and we ask your Honors to carefully examine the designs shown at the page quoted.

Can there be any possible doubt that the Hammond design fulfills every requirement of the test laid down by the Supreme Court in the case quoted? That test is *a new appearance to the eye*; or, as was said by Lord Westbury in the case of *Holdsworth vs. McUrea* (2 App. Cases H. of L., 388), quoted by the Supreme Court in its decision of the Gorham case:

"In the case of those things in which the merit of the invention lies in the drawing, or in forms that can be copied, the appeal is to the eye, and the eye alone is the judge of the identity of the two things. Whether, therefore, there be piracy or not is referred to *an unerring judge, namely, the eye.*"

If this is the proper test of the presence of invention, and if the eye is the unerring judge to determine it, then it must follow as an absolute fact that the decision of











this court in the case at bar is erroneous. *That Hammond's design produced a new appearance to the eye cannot be denied; nor can it be denied that the design is graceful, attractive and beautiful, one which increases the salableness of the article, delights the æsthetic nature and adds new functions and capacity to the car.*

Let us apply the test given by Lord Westbury and decided by the Supreme Court to be the proper one, and accordingly we herewith reproduce on adjoining pages a picture of the Hammond design, together with a picture of the old Market-street cable car, for the purpose of comparison. The picture of Hammond's design is taken from a photograph, which is an Exhibit in the case, which photograph represents the first car built by the patentee. The picture of the Market-street car is a reproduction of the patent drawings offered in evidence in the case by the defendant to show the appearance of the old Market-street dummy.

Now we submit that if we apply *the test of the eye* to this problem, there can be no question as to its proper solution. Who is there with such blunted artistic sensibilities, such poverty of æsthetic taste as to deny beauty to the Hammond picture? Is not this the "new and original appearance to a manufactured article which may enhance its saleable value, may enlarge the demand for it and may be of meritorious service to the public" spoken of by the Supreme Court? Does it not present a new appearance to the eye and one which is beautiful and attractive?

To ask these questions is to answer them. *Indeed they were all found as facts in our favor by the lower court.*

Now examine for a moment the picture of the Market-street car. Is there any sameness of appearance between the two? Are they not different *in appearance*? Would the two cars appear the same to the eye of the most ordinary observer? Is there not a clearly defined and distinct difference in appearance between the two? To answer these questions we have merely to appeal to *that unerring judge* spoken of by Lord Westbury, to wit: *the eye*.

In fact *an appeal to the eye* in this case is an end to the controversy, for it cannot be denied that the Hammond design *is the product of an original conception; that it is new and useful; that it presents a beautiful and artistic appearance*. Therefore, it fulfills every requirement that the law lays down for the construction of design patents.

“But,” says this court in answer to our position, “you produce that new appearance, that new result, *by merely duplicating the old Market-street dummy*, and duplication is not invention, but only an exercise of the imitative faculties.” In answer to this, we have again to refer your Honors to the language of Mr. Justice Strong in the case of *Gorham vs. White*, at page 525, as follows:

“And the thing invented or produced for which a patent is given is that which gives a *peculiar or distinctive appearance* to the manufacture or article to which it may be applied, or to which it gives form. \* \* \* Manifestly *the mode in which those appearances are produced has very little, if anything, to do with giving increased salableness to the article*. It is the appearance itself which attracts attention and calls out favor or dislike. It is the appearance itself, therefore, NO MATTER BY WHAT AGENCY

CAUSED, that constitutes mainly, if not entirely, the contribution to the public which the law deems worth of recompense.”

Of what moment, therefore, in view of this language, is it that we produce the new appearance by what the court terms *duplication*? It matters not whether that result was obtained by duplication, multiplication, subtraction, omission, or addition—the thing to look at is the result itself, and, if that result has a new and pleasing appearance, then the requirements of the statute are satisfied. “*It is THE APPEARANCE ITSELF therefore, NO MATTER BY WHAT AGENCY CAUSED, that constitutes mainly, if not entirely, the contribution to the public which the law deems worthy of recompense.*”

We submit, therefore, that the question of *duplication* does not enter into the problem, because, if by duplication an entirely new appearance is produced, then it is patentable, because the patent is given for the thing itself, for the product produced, and not for the manner or means by which it is produced. If the product has a new appearance, it is patentable, *no matter by what agency it is produced*. This, we submit, is the doctrine laid down by the Supreme Court of the United States in the Gorham case.

Why was the design involved in that case a patentable one? By examining it your Honors will see that it was very simple. Indeed it was a common ordinary scroll work which any draftsman could produce at a moment's notice. But its use on spoons gave to the spoons a new and pleasing appearance which made them more attractive and beautiful to look at. That was the basis of pat-

entability. That was the test. We submit that the same test, if applied to Hammond's design, will uphold its patentability.

In *Miller vs. Smith* (5 Fed. Rep., 359), the patent sued on covered a design for jewelry, principally sleeve buttons, consisting substantially of rustic letters used as initials with an ornamentation of leaves. The court described the design as follows:

“It consists of the letters of the alphabet \* \* \* which are of a rustic pattern, ornamented by leaves, the claim being for sleeve buttons and other jewelry composed of the letters of the alphabet, and having the described ornamentation of letters, substantially as given in the description.”

And further on in his description of the device the court says:

“Rustic letters are employed, by which is meant, as the complainants allege, letters in which the necessary lines of the same represent the branches or trunks of trees, unstripped of the bark, the ornamentation consisting of several separate leaves placed at intervals upon the lines of each letter, the lines exhibiting the appearance of the bark of a branch or trunk of a tree, which design is used for ornamenting buttons, studs, lockets and other articles of jewelry.”

Although initial-letter sleeve buttons were old and the use of rustic letters was old, yet the patent was sustained by Judge Clifford as being valid. The doctrine of this case was subsequently applied and the opinion of Judge Clifford was referred to as controlling authority in *Untermeyer vs. Freund* (37 Fed. Rep., 345), and *Ripley vs. Elson Glass Co.* (49 Fed. Rep., 928).



In the case of *Wood vs. Dolby* (7 Fed. Rep., 475), the patent covered a design for jewelry settings, consisting of a bird perched upon a twig, with the representation of a leaf above and a panel below, with a diamond on the leaf and two diamonds on the panels.

It was shown in defense that bird designs of slightly different appearance were old in connection with jewelry, but Judge Wheeler sustained the patent, and in rendering his decision said.

“The patent is for THE APPEARANCE which the design will add to articles of jewelry, making them desirable according to its attractiveness to those who may be observers and want them, and it is the right to the exclusive use of this which is secured by it to the orator.”

He then cited as authority for this the decision of the Supreme Court in *Gorham Co. vs. White* (14 Wall., 371).

In *Simpson vs. Davis* (12 Fed. Rep., 144), the patent by its seventh claim covered a newel post of a certain shape and configuration, having as ornament a scroll, a bead and roses. Judge Benedict upheld the patent, and, in rendering his decision, said amongst other things, speaking of the fifth claim of the patent:

“The claim does not seek to secure the scroll by itself, nor the bead by itself, nor the roses by themselves. Each of these is an ornament, but neither of them is new. The claim, therefore, seeks to cover these forms associated together in the manner described as composing a single ornament. In the matter of ornamentation *mere juxtaposition of old forms is doubtless sufficient to authorize a patent for an ornament when, by means of such juxtaposition, accomplished by industry, genius, effort and expense, the old forms are*

*made to become component parts of an ornament substantially new in its effect.* \* \* \* The amount of the novelty may be small, but the effect of the ornament must, to some extent at least, be new. The ornament may, in this sense, be new and original, although all the forms used in its composition are old and well known forms of ornamentation. The claim under consideration is, therefore, not defeated when it is shown that scrolls similar in effect to the scroll described in the claim, and that beads and roses such as those described, have often before been employed in the ornamentation of newel posts."

And the second head-note of the syllabus of the case reads as follows:

"The statute permits a patent for any new, useful and original shape or configuration of any manufacture; and where the arrangement of ornament and shape is new, useful and original, the invention is patentable."

If we subject the Hammond car-body to this test, there will be no difficulty in sustaining the patent, for it is certainly *new*, because the lower court has so found. For the same reason it is *useful*, and for the same reason it is *original*.

The findings say (Record, p. 20): "Prior to June 22, 1891, plaintiff, John Hammond; by his own industry, genius, effort and expense, conceived, devised and produced a new and original design for a manufacture, to wit: a *new, useful and original* shape and configuration of a car-body."

Unless, therefore, the syllabus quoted from *Simpson vs. Davis* is absolute error, the decision rendered in the case at bar cannot stand.

The case of *Streat vs. White* (35 Fed. Rep., 426), decided by Judge Shipman, is instructive and valuable as showing the nature of the inventive faculty in producing patentable designs. The design there in question was a design for printing textile fabrics, *which was simply a copy or imitation of an old and well-known design that had been used for a woven fabric commonly known as "seersucker."* From this fact the case is commonly referred to as the "Seersucker case." It appears from the case that the article known as seersucker is a *woven fabric* having a peculiar crinkled appearance, and the patentee conceived the idea to *imitate and copy* that appearance as a design for *textile fabrics* specially to be employed in printing calicos and similar fabrics. The nature of the case may be understood from the following language used by Judge Shipman:

"This (the claim of the patent) was intended to be and was *an imitation in printed cloths of a well-known and popular woven fabric called 'seersucker,'* which presents a smooth stripe alternating with a ridged or crinkled stripe. The object of the alternate light and dark cross lines in the stripes was to represent the crinkled effect of the corresponding woven stripe in the seersucker. The idea of imitating in printed cloths the woven seersucker was not a new one at the date of the alleged invention. It had frequently been attempted. Alternate light and dark cross-bars at right angles with the stripe, to imitate the crinkled appearance of the ridged stripe, had been used; but I assume that the blending into each other of these lines by shading was novel. The design quickly attracted the fancy and the favor of the public, and became very popular."

Accordingly he held that the design did involve invention. The views of Judge Shipman in this case were afterwards affirmed by Judge Wheeler in the case of *Streat vs. Simpson* (53 Fed. Rep., 358), where the same patent was involved. It was there shown that the invention consisted in nothing more than *the imitation of seersucker on printed fabrics*, and it was said:

“That he” (the patentee) “got the idea of his pattern from seersucker would not prevent a patent for his pattern.”

Is it not apparent that all the patentee did was to transfer to the printed textile fabric a design shown upon a woven fabric known as seersucker? There certainly appears to have been more of the imitative faculty exercised there than in Hammond’s case, and nevertheless the design was held to show invention. We may add that the patent was declared void, not because the imitation of seersucker was no invention, but because the patentee was not the real inventor thereof, it appearing that the engraver who made the pattern was the real inventor. The real point of the case is that the imitation of old forms, when applied to other objects, is patentable, if a new appearance is produced. It makes no difference *how* or *by what agency* the new appearance is produced, not even if produced by imitation of old forms. This was merely following the rule laid down in *Gorham vs. White, supra*.

In *Foster vs. Crossin* (23 Fed. Rep., 400), we find a design for jewelry pins consisting of a spoon-shaped plate having a peculiar rounded edge. Judge Carpenter, who heard the case, stated the problem before the court as follows:

“It is, therefore, necessary for the complainant to maintain the proposition that the rounded and smoothly finished edge constitutes such a distinctive feature of the design as will support the patents. \* \* \* Design of course relates SOLELY TO THE APPEARANCE OF THE ARTICLE to the ordinary purchaser; and when the question is whether a difference of design be substantial and valuable, surely there can be no test better than the practical test which is furnished by observing the effect of the two designs on the appreciating observation of the purchasing public. I conclude that in this case the design is sufficiently distinctive to support the patents.”

In *Redway vs. Ohio Stove Co.* (38 Fed. Rep., 582), was involved a design for a cooking stove consisting of ornamentations for the doors, and also a peculiar configuration and ornamentation for the legs of the stove. The defenses relied on were that these designs were not novel, that they were not inventions and not patentable. Said Judge Sage in deciding the case:

“Now what is the proper test of the validity of a design patent? The statute (section 4929, Rev. St.), authorizes, among other things, the granting of a patent to any person who has, by his own industry, genius, efforts and expense invented and produced any new and original design for an ornament to be cast on any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented, or described in any patented publication. The design must be new and original and an invention. But there need not be a great invention. That is not essential to the validity of any patent. The statute must



have a construction reasonable and at the same time favorable to its beneficial operation. As was said by the court in *Simpson vs. Davis* (12 Fed. Rep., 145), the result of the industry, genius, effort and expense employed must be a single ornament, which, taken as a whole, can be considered to be the embodiment of a new idea in ornamentation. The amount of the novelty may be small, but the effect of the ornament must, to some extent at least, be new. The ornament may, in this sense, be new and original, although all the forms used in its composition are old and well-known forms of ornamentation."

*Untermeyer vs. Freund* (37 Fed. Rep., 342), is a leading case. The design there in question consisted of a central conventional star in which any ornament might be set, placed upon a larger star of leaves, to be used as an ornament for watch cases. In other words, it was merely a conventional star superimposed upon a larger star. The main defense relied on was an asserted want of invention, but Judge Coxe, in a well considered opinion, which has been referred to in a number of subsequent cases as high authority, said:

"A design requires invention, but a different set of faculties are brought into action from those required to produce a new process or a new machine. In each case there must be novelty, but the design need not be useful in the popular sense. It must be beautiful. It must appeal to the eye. The distinction is a metaphysical one, and difficult to put into words. A flying wheel, a wheel revolving rapidly between two outstretched wings, present a pleasing object to the eye; a graceful pattern

“ for the handle of a spoon or fork may attract many  
“ purchasers, and yet it cannot be said that the embodi-  
“ ment of these designs requires any exercise of the ‘in-  
“ tuitive faculty of the mind ’ in the sense that this faculty  
“ is exercised in inventions like the telephone or the safety  
“ lamp. The policy which protects a design is akin to  
“ that which protects the work of an artist, a sculptor or  
“ a photographer by copyright. It requires but little in-  
“ vention, in the sense above referred to, to paint a  
“ pleasing picture, and yet the picture is protected, be-  
“ cause it exhibits the personal characteristics of the artist,  
“ and because it is his. So with designs. If it presents  
“ a different impression upon the eye from anything  
“ which precedes it; if it proves to be pleasing, attractive  
“ and popular; if it creates a demand for the goods of its  
“ originator, even though it be simple and does not show  
“ a wide departure from other designs, its use will be pro-  
“ tected. In the active competition of trade a dealer is  
“ fairly entitled to the advantage, slight though it be,  
“ which attends such enterprise, and a rival in business  
“ should not be permitted thus openly and defiantly to  
“ invade the territory of another. It is easy for every  
“ dealer, with the wide universe before him, to select a  
“ design of his own; the appropriation by him of the de-  
“ sign of his neighbor is usually so unnecessary and un-  
“ warrantable that the law is seldom relaxed for his  
“ advantage. It is impossible to read the literature upon  
“ this subject without being convinced that the courts,  
“ though applying the same rules, have looked with  
“ greater leniency upon design patents than patents for  
“ other inventions. From the nature of the case it must



“ be so. A design patent necessarily must relate to sub-  
 “ ject matter comparatively trivial. The object of the  
 “ law is to encourage those who have industry and genius  
 “ sufficient to originate objects which give pleasure  
 “ through the sense of sight.”

Following closely the lines of this decision came the case of *Ripley vs. Elson Glass Works* (49 Fed. Rep., 927), where the patent covered a design for the shape of glass bottles and jars, consisting of a spherical body and a figured neck. It was held valid by Judge Jackson, then on the circuit bench. In passing on the question of infringement, he used the following language, which is equally applicable *mutatis mutandis* to the question of invention:

“And upon the question of substantial identity or similarity in design patents, the test to be employed or applied is not the eye of the expert, but that of the ordinary observer, giving such attention as would ordinarily be given by a purchaser of the article bearing the design. In *Gorham Co. vs. White*, 14 Wall., 528, the rule is stated thus:

“ ‘ We hold, therefore, that if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same—if the resemblance is such as to deceive such an observer, inducing him to purchase one, supposing it to be the other—the first one patented is infringed by the other.’

“The test of infringement in design patents is more analogous to that applied in ‘trade-mark’ cases than to that adopted in respect to patents on mechanism. Testimony of experts is admissible in determining whether

two mechanisms are substantially identical, while in design patents, resting almost wholly upon 'appearances,' the test of sameness is determined by the eye of the ordinary observer, giving such attention as a purchaser usually gives, which is substantially the same principle applied in trade-mark cases."

This case was appealed to the Circuit Court of Appeals and there affirmed (20 U. S. App., 32).

If your Honors will examine the case as there reported, you will there see reproductions of the design in question, and upon a comparison thereof with the Hammond design, we submit that the latter cannot be denied the attribute of invention if the first cannot.

After that came the leading case of *Smith vs. Stewart* (55 Fed. Rep., 481), where the design consisted of certain well known Masonic symbols placed on rugs and grouped in an orderly and tasteful manner, so as to form an attractive panel. It was held by Judge Butler to involve invention, although the symbols were hundreds of years old, and the syllabus says:

"The invention and novelty required in the case of design patents is very small and of low order, and differs from the invention and novelty required for mechanical patents. All that the statute requires in the case of designs is the production of a new and pleasing design which may add value to the object for which it was intended."

And in rendering his decision the learned Judge said, *inter alia*:

"If the question what constitutes novelty and invention, in the sense of the statute here involved, was now

raised for the first time, I might possibly agree with the defendants. It has, however, been raised many times heretofore; and, while the decisions are substantially harmonious, the expressions of commissioners and judges regarding it are not. I have examined the cases, but do not propose to discuss them. The application of expressions found in a few of them would, I think, overturn a majority of design patents granted, and many of those which have been sustained by the courts. It would seem absurd to say that the designs covered by these patents, generally, exhibit the exercise of 'inventive genius,' as the term is commonly applied to mechanical inventions. Turning, for example, to the spoon and fork handle design in the hotly contested case of *Gorham Co. vs. White*, 14 Wall., 511, nothing more is found than the skillful use of common scroll work, exhibiting little if anything, more than good taste; and yet the question of novelty and invention was not even raised; the same may be said of the designs involved in a majority of reported cases. Some of the rules applied to mechanical patents are wholly inapplicable to those for designs. As said by the Supreme Court in *Gorham Co. vs. White*: 'To speak of the invention as a combination \* \* \* or to treat it as such is to overlook its peculiarities.' Such designs generally, if not uniformly, contain nothing new except the appearance presented to the eye, by arrangement of previously existing material; such as lines, scrolls, flowers, leaves, birds and the like. The combination, where several separate objects are employed, need not be and cannot be, such as this term signifies when applied to machinery—'the parts coacting to produce a new and useful result' in the

sense there contemplated. The object sought in a design is a new effect upon the eye alone—a new appearance; and the several parts need not have any other connection than is necessary to accomplish this result. As the Supreme Court said in the case just cited: ‘It is the appearance simply, no matter by what agency caused, that constitutes mainly, if not entirely, the contribution to the public which the law of design patents deems worthy of recompense. This appearance may be the result of peculiarity of configuration, of one element alone, or of several conjointly; but in whatever way produced,’ it is the new appearance only which the law regards. The invention in a majority of patented designs is very small and of a low order. All the statute, as commonly interpreted, requires, is the production of a new and pleasing design, which may add value to the object for which it is intended. The invention consists in the conception and production of this, however simple it may be. As said in *Robinson on Patents* (page 293): ‘The essence of a design resides in the idea of that configuration or ornamentation which constitutes the new appearance given.’ And again, as said in *Untermeyer vs. Freund*, 37 Fed. Rep., 342: ‘If a design presents a different impression upon the eye from anything which preceded it, if it proves to be pleasing and popular, if it creates a demand for the article to which it is applied, though it be simple and does not show a wide departure from other designs, it will be protected.’ See *Simpson vs. Davis*, 20 Blatch., 413; 12 Fed. Rep., 144. See also, in this connection, *Wood vs. Dolby*, 7 Fed. Rep., 475, where a design which consisted of a bird upon a twig with various unconnected

accessories, was held to be new and patentable, although bird designs of slightly different appearance were found to be old.

“ In the case before us the object sought was a masonic design for decorating rugs, by means of which they might be made popular with members of that and similar orders. He therefore selected certain masonic symbols and grouped them in an orderly and tastefully manner, so as to form what many would consider an attractive panel large enough to cover the face of the rug. He succeeded in his object; the rug became popular and met with an active demand. The invention consisted in the conception of this design and carrying it into practical effect.”

This case was subsequently affirmed on appeal and the opinion of Judge Butler adopted and affirmed to be sound. (58 Fed. Rep., 580.)

The last case we refer to in this connection is the very recent one of *Braddock Glass Co. vs. Macbeth* (64 Fed. Rep., 118), decided by the Circuit Court of Appeals for the third circuit. The decision of the lower court is reported at page 173 of the Federal Reporter. The nature of the inventions will be more clearly ascertained, however, from the case of *Macbeth vs. Gillinder* (54 Fed. Rep., 171). It there appears that the patent in suit covered a design for lamp chimneys having a circular or flared mouth with a beading or similar ornamentation on the top. The specification of the patent stated that the object of the design was to form an ornamentation for the top of a lamp chimney consisting essentially in a lamp chimney having a circular edge and a beading or similar



ornamentation raised above the edge. The top of the chimney presented to the eye the regular flared circular top of the ordinary plain chimney and a finish of beading or light ornamentation around the top. The claims of the patent, which were two in number, read as follows:

“ 1. The design for lamp chimney tops herein shown and described consisting in a circular top or edge and a beading or similar ornamentation raised above the said edge.

“ 2. The design for lamp chimney tops herein shown and described, consisting in a flared mouth having a circular top or edge and a beading or similar ornamentation raised above said edge.”

The chimneys were known to the trade as “ Pearl top chimneys.”

In the syllabus of the case as reported in 64 Federal Reporter, 118, it is said:

“ The novelty of a design is to be tested, not by investigation of the means employed for its creation, but by ocular comparison of the design itself with prior designs which are alleged to be substantially the same. A design will be held to be an infringement where it unquestionably produces the same effect upon the eye as that of a patented design.”

The opinion of the Court of Appeals was rendered by Dallas, Circuit Judge. It was assigned as error by the defendant that the court erred in holding that it was patentable merely to double the number of crimps at the top of a chimney. The court said in reference to this assignment of error:

“ The decree does not embody a finding that it was

patentable merely to double the number of crimps at the top of a chimney, and that position is not taken in the opinion of the Circuit Court, nor is it necessary or even pertinent for its conclusion. The argument for the appellant would be of greater force if the patent in suit, instead of being for a design, was for the mechanism of its construction. It has been made plainly obvious to us and seems to be fully recognized by the trade, that the appearance of the patented design is very different from that of any other which had previously existed; and this being so, the method of its production is irrelevant. The novelty of a design is to be tested, not by investigation of the means employed for its creation, but by ocular comparison of the design itself with the prior designs which are alleged to be substantially the same, and when weighed by this test the novelty of the design covered by the patent in suit is made quite apparent. The second assignment presents conversely the same question as the first, and for like reasons cannot be sustained. The design of the appellant produced the same effect upon the eye as that of the appellee, and therefore the former conflicts with the latter."

Accordingly the court of last resort held the design to be patentable.

We find a close analogy to the law of designs in that of copyrights. The law allows a copyright to the "author, *inventor*, designer or proprietor of any book, map, chart, dramatic or musical composition, engraving, cut, print or photograph or negative thereof, or of a painting, drawing, chromo, statue, statuary, and of models or designs intended to be perfected as works of the fine arts" (§ 4952 R. S.)



Note carefully the wording of this statute—"author, *inventor*, designer or proprietor," and compare it with the wording of the design Patent Act—"any person who by his own industry, genius, efforts and expense has invented and produced any new and useful design for a manufacture, etc." (§ 4929 R. S.)

Again, consider the subject-matter of a copyright in comparison with that of a design. The one is granted for "books, maps, charts, dramatic and musical compositions, engravings, cuts, prints, photographs, paintings, drawings, chromos, statues, statuary and models or designs intended to be perfected as works of the fine arts;" the other for "designs for manufactures, busts, statues, alto-relievos, bas-reliefs, prints of woolen, silk, cotton and other fabrics, impressions, ornaments, patterns, prints and pictures to be painted, printed, cast or otherwise placed on or worked into articles of manufacture, shapes and configurations of articles of manufacture."

Is it not plain that these two statutes are *in pari materia* and intended for kindred and analogous purposes? Is not the general policy of the two the same? And is not that policy to protect works of an artistic, æsthetic and decorative nature, works which appeal to the æsthetic nature as distinguished from the utilitarian? We think the most superficial reader must so conclude. And if this be true, is it not likewise true that the same general rules of law must apply in both cases? Indeed, it has been directly so held by Judge Coxe in *Untermeyer vs. Freund* (37 Fed. Rep., 344) where he said: "The policy which protects a design is akin to that which protects the works of an artist, a sculptor, or a photographer by a copyright."

What possible difference can there be in principle between the policy of a law which protects the artistic beauty of a map, or photograph, or painting, and one which protects the artistic beauty of a picture, impression, or design imparted to articles of manufacture, such as silverware, ladies' silks, carpets, jewelry, etc., etc.? Indeed, in one respect, as regards subject-matter, the two statutes are identical, because the one mentions "statues and statuary"; the other, "busts, statues, alto-relievos and bas-reliefs."

Such being the case, let us now briefly note the rule laid down for testing the validity of a copyright.

In *Lithograph Co. vs. Sarony* (111 U. S., 53) we find that Sarony, the New York photographer, secured a copyright for a photograph which he had taken of Oscar Wilde. It was urged by the defendant that the work of a photographer "is the mere mechanical reproduction of the physical features or outlines of some object, animate or inanimate, and involves no originality of thought or any novelty in the intellectual operation connected with its visible reproduction in shape of a picture; \* \* \* that the process was merely mechanical, with no place for novelty, invention or originality."

It was further urged: "It is simply the manual operation, by the use of these instruments and preparations, of transferring to the plate the visible representation of some existing object, the accuracy of this representation being its highest merit."

But the Supreme Court took no stock in such reasoning, and through Mr. Justice Miller sustained the copyright on the ground that the photographer had produced

“a useful, new, harmonious, characteristic and graceful picture \* \* \* by posing his subject to the best advantage in relation to costume, draperies, and other accessories, etc., etc.”

In *Falk vs. T. P. Howell & Co.* (37 Fed. Rep., 202), plaintiff had copyrighted a photograph of the opera singer Geraldine Ulmer, dressed in the costume of “Yum Yum.”

In *Falk vs. Gast* (48 Fed. Rep., 262, affirmed by the Court of Appeals in 54 Fed. Rep., 891), the copyright covered a photograph of Julia Marlowe; in *Falk vs. Schumacher* (48 *Id.*, 222), a photograph of Lillian Russell; in *Falk vs. Brett* (48 *Id.*, 678), a photograph of Josie Sadler; in *Falk vs. Donaldson* (57 *Id.*, 32), the photograph of Julia Marlowe in the character of Parthenia; in *Press Publishing Co. vs. Falk* (59 *Id.*, 324), the photograph of Marie Jansen in the character of “Nadjy.”

In all these cases the copyright was held good on the ground stated by Judge Townsend in *Falk vs. Donaldson* (57 Fed. Rep., 34) that in such cases the photographer, by arranging and posing the subject in the best attitude, becomes “the author of an original work of art, the product of his intellectual invention.”

In all these cases the artist certainly in one sense exercised the “imitative faculty.” The only originality or invention displayed was in arranging the sitter in the best attitude for producing an artistic effect; but that small amount of originality and invention was sufficient to meet the requirements of the statute.

Now compare this with the case at bar. Hammond

undoubtedly exercised the imitative faculty in the manual duplication of the old dummy, just as the photographer did in the manual reproduction of the picture of the person photographed by means of the camera and its accessories. But Hammond did not exercise the imitative faculty in the original conception that by duplicating the dummy and so arranging it with relation to the car-body he could produce a new picture. The photographer's problem was to so arrange and pose his subject with relation to surrounding objects, background, light, shade, etc., as to produce a new and pleasing picture possessing artistic merit. The problem of Hammond was to provide a second dummy and so arrange it with relation to the first dummy and to the car-body, trucks, wheels, etc., as to produce a new and pleasing appearance. There was just as much originality and invention in conceiving and actually making that arrangement, as there was in arranging the drapery of an actress' dress, background and surroundings to produce an artistic effect in a photograph. We fail to perceive the slightest distinction between the two cases. If the photograph entitles the artist to be called the "author of an original work of art, the product of his intellectual invention," then Hammond must stand on the same footing as regards his design for car-bodies.

We might cite many more cases to sustain the views we have advanced concerning the test of invention in the case of design patents, but we opine that those cited are sufficient to sustain the conclusions we seek to deduce and which may be formulated as follows:

1. The aim of the Design Patent Act is to protect "new appearances" that may be given to articles.

2. Hence, the first inquiry, in case of a design patent, is whether a new appearance has been given to the article.

3. To answer that query an appeal must be made to "an unerring judge, the eye."

4. If the answer to this query be in the affirmative, then it is immaterial as to how or by what agency this new appearance is produced (*Gorham vs White*).

5. The imitating and copying of various old designs, and grouping and arranging them together into one article so as to produce a harmonious whole which presents a new appearance that is pleasant to the eye, may be an exercise of the inventive faculty sufficient to sustain a patent for a design.

6. The minimum amount of invention required to produce a patentable design is very small and of the lowest order, and differs materially from the quality of invention required to produce a patentable mechanism.

7. In determining the presence of invention in designs the rules applicable to mechanical patents cannot be applied with their usual strictness and vigor, but must be softened and modified to carry out the policy of the Design Patent Act.

8. The patent itself being *prima facie* evidence of invention, and the new appearance, if found as a fact to exist, being further evidence of invention, its quick and extensive adoption by the public being still further evidence of invention, and the law in any event requiring only a minimum of invention, and in doubtful cases de-

aiding in favor of the patent, we submit that the Hammond design is not void for want of invention.

All of which is respectfully submitted.

JOHN H. MILLER,

Of Counsel for Petitioner.

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### Certificate.

I, John H. Miller, do hereby certify that I am of counsel for John Hammond, petitioner in this case, and in my judgment the foregoing petition is well founded in point of law, and ought to be granted.

JOHN H. MILLER.